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REMARKS

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 1-18 are pending, of which claims 1, 7, and 12 are independent. Claims 2-10 and 12-14 are amended for consistency. Claims 7-10 are further amended to provide for infringement when the goods are sold, prior to being used. Claims 15-18 are added to provide Applicants with the protection to which they are deemed entitled.

Applicants traverse the rejections under 35 U.S.C. §103(a) of claims 1-9 and 12 as being unpatentable over DeLuca et al. (U.S. 5,848,270) and of claims 10, 11, 13, and 14 as being unpatentable over DeLuca in view of Datta et al. (U.S. 6,209,033)

Independent claim 1 is directed to method of managing a plurality of user accounts assigned to a computer entity having a combination of steps, including comparing the predicted utilization of functionality with a currently available amount of unused functionality of a computer entity, and allowing or disallowing addition of a new user account onto the computer entity, depending upon a result of the comparison.

Independent claim 7 is directed to a computer entity having a combination of elements, including a compare component for

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comparing a predicted future utilization of the plurality of user accounts with a data storage capacity currently available for use on the data storage device, and a control component arranged to activate the prediction component and compare component.

Independent claim 12 is directed to a method of operating a computer entity comprising at least one data processor and a data storage device for automatically admitting or rejecting a new user account onto the computer entity having a combination of steps including, in response to a request to add a new user account to the computer entity, comparing currently unused functionality with predicted future utilization of functionality and, depending upon the results of the comparison, allowing or disallowing entry of the new user account onto the computer entity.

None of the references of record, including DeLuca and Datta, discloses or suggests a method or apparatus having the above-noted combinations of elements and steps set forth in Applicants' independent claims 1, 7, and 12.

In contrast to Applicants' claimed invention, DeLuca merely discloses a method and system for determining appropriate hardware for a computer system ("sizing"; see column 1, lines 19-25). DeLuca's system and method allows sizing without actually building the system (see column 2, lines 41-48). Described embodiments deal

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with specifying, among other items, the number of CPU's (see column 7, line 59, through column 8, line 15), and minimum memory (see column 8, lines 45-50),

At column 12, DeLuca indicates that analysis can be performed to determine whether an existing server can meet the requirements of the modeled server system. However, the comparison merely determines if the existing system has hardware equal to or greater than that which the model decides is needed (see column 12, lines 30-44).

Deluca, therefore, does not disclose or suggest comparing predicted future utilization of functionality with a current amount of unused functionality and allowing or disallowing addition of a new user account onto the computer entity, depending upon a result of the comparison, as required by Applicants' independent claim 1; or a compare component for comparing predicted future utilization of a plurality of user accounts with a data storage capacity currently available for use on a data storage device, and a control component arranged to activate the prediction component and compare component, as set forth in Applicants' independent claim 7; or comparing currently unused functionality with said predicted future utilization of functionality and, depending upon the results of the comparison, allowing or disallowing entry of a new user account

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onto a computer entity, as recited in Applicants' independent claim 12.

There is no reason why one of ordinary skill in the art would take into account current unused functionality as DeLuca is only concerned with determining whether hardware would "adequately operate at the expected performance requirements of the modelled server system" (see column 3, lines 5-8).

Applicants fail to understand the basis for the Examiner's statements regarding what would be obvious to one of ordinary skill in the art based on DeLuca. Although the Office Action refers to what is allegedly "based on logic reason," the courts have held and the MPEP requires there to be some form of evidence in the record to support an assertion of common knowledge. Any assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. General conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art, without specific factual findings and some concrete evidence in the record to support these findings, will not support an obviousness rejection. *In re Lee*, 277 F.3d, 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), and *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

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If the Examiner is relying on inherency, it is respectfully submitted that the burden of establishing a *prima facie* case of inherency has not been met.

The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).

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Since no rationale or evidence has been provided to show that the cited portions of DeLuca inherently disclose the above-noted features of Applicants' independent claims 1, 7, and 12, the rejections of based on DeLuca are incorrect and must be withdrawn.

Since the remaining claims depend from allowable independent claims 1, 7, and 12, they are also allowable due to their dependence on allowable independent claims, as well as for the additional limitations provided by these claims.

Regarding claims 2-6, for example, utilization per user is calculated in DeLuca in accordance with formula (9) in column 8. It should be noted that storage capacity is not linked to number of users, merely database size. This is because DeLuca focuses on hardware specification for multi-user database servers (see column 1, lines 6-8, referring to multi-user systems). In addition, storage capacity appears to be solely dependent on an expected database size (see column 10, lines 53-56). In multi-user database systems, some users may only have browsing/querying rights. Even if a user were inputting data into the database, storage capacity would be dependent on record size and expected number of records to be stored. This appears to be why expected requirements for storage capacity are input into the DeLuca system rather than being calculated.

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There appears to be no capability to take into account individual user accounts, historical utilization per account or a particular prediction algorithm per account. With regard to paragraph 7, the Office Action does not indicate where the features of claim 5 allegedly can be found, nor can Applicants find any such disclosure.

Datta fails to cure the deficiencies of Deluca as a primary reference. Datta is concerned with network capacity and traffic carried by communication links. Datta does not disclose or suggest monitoring of data storage systems. Furthermore, the cited passage at column 12, lines 40-61, discusses modeling of alternate network configurations to achieve better usage of link capacity. The parameters changed are for the network configuration model and have nothing to do with modification of alert parameters. Datta, therefore, fails to teach the features asserted in the Office Action.

Even if one of ordinary skill in the art were to consider combining the disclosures of Datta and DeLuca (which seems unlikely since one is concerned with specifying new hardware and does not consider networks, while the other is purely concerned with network performance), the combination would still fail to disclose or suggest Applicants' presently claimed invention.

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In view of the foregoing amendments and remarks, favorable reconsideration and allowance are in order.

Pursuant to 37 C.F.R. §1.136(a), Applicants hereby request a one-month extension of time in which to file this response and hereby authorize the Commissioner to charge the required fee of \$110, as well as any prescribed fees not otherwise paid, including application processing, extension, and extra claims fees, to Deposit Account No. 68-2025.

Respectfully submitted,
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